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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/886,851

Applicant(s)

CONLEY ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Pub No 2002/0065941 issued to Kaan et al (hereafter Kaan '941).

Regarding claim 13, Kaan '941 discloses:

reading preprocessing information, the preprocessing information including override information for nullifying information associated with one or more sites or one or more site links from one or more router configuration files [paragraph 0038]

reading router interface information from a router configuration file associated with each of one or more routers, wherein one or more site references is generated by identifying a sub-network on a Local Area Network (LAN) [Fig 1, 130] interface and one or more site link references by identifying a Wide Area Network (WAN) [Fig 1, 110] interface

wherein the override information is applied to the site and site link references [Fig 1, 100]

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaan '941

Regarding claim 14, Kaan '941 discloses generating a router name [paragraph 0078] but does not disclose generating a name exception. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaan '941 to include generating a name exception for the purpose of determining a change in names.

5. Claims 15-17, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaan '941 as applied to claim 14 above, and further in view of US Pat No 4,853,843 issued to Ecklund (hereafter Ecklund '843)

Regarding claims 15 and 16, Kaan '941 discloses the essential elements of the claimed invention as noted above except for a temporary site name. Ecklund '843 discloses a temporary site name. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaan '941 to include a temporary site name as taught by Ecklund '843 for the purpose of processing requests when failures occur [col 16, line 14]

Regarding claim 17, the combination of Kaan '941 and Ecklund '843 disclose the essential elements of the claimed invention as noted above except for generating a sub-network with the temporary site name. It would have been obvious to one of ordinary skill in the art at

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the time the invention was made to modify the combination of Kaan '941 and Ecklund '843 to include a sub-network with a temporary name for then purpose of creating a LAN [refer abstract of Kaan '843].

Regarding claims 20 and 23, Kaan '941 discloses the essential elements of the claimed invention as noted above except for merging one or more temporary site names and associated partial site links, site links, sub-network references, and router names into one or more newly created complete site names, and deleting from processing the one or more temporary site names merged into the one or more newly created completed site names, thereby reducing the quantity of temporary site names and increasing the quantity of site references associated with one or more temporary site names. Ecklund '843 discloses merging one or more temporary site names and associated partial site links, site links, sub-network references, and router names into one or more newly crated complete site names, and deleting from processing the one or more temporary site names merged into the one or more newly created completed site names, thereby reducing the quantity of temporary site names and increasing the quantity of site references associated with one or more temporary site names [Fig 10]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaan '941 to include merging one or more temporary site names and associated partial site links, site links, sub-network references, and router names into one or more newly crated complete site names, and deleting from processing the one or more temporary site names merged into the one or more newly created completed site names, thereby reducing the quantity of temporary site names and increasing the quantity of site references associated with one or more temporary site names as taught by

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Ecklund '843 for the purpose of merging virtual partitions in a distributed data base system [col 1, lines 5-10].

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaan '941 as applied to claim 13 and further in view of in view of US Pat No 5,968,121 issued to Logan et al (hereafter Logan '121)

Regarding claim 18, Kaan '941 discloses the essential elements of the claimed invention as noted above except for:

reading a list of one or more site names from a data storage associated with a network management system

reading from the data storage a list of one or more preprocessing site links and associated site link costs

comparing one or more site names parsed from one or more preprocessing site links to the list of one or more site names from the data storage and discarding one or more preprocessing site links upon failure to match

reading from the data storage a list of one or more preprocessing address blocks and at least one from a set consisting of a preprocessing site name associated with the one or more preprocessing address blocks or a command to ignore the one or more preprocessing address blocks

comparing the preprocessing site name associated with the one or more preprocessing address blocks to the list of one or more site names from the data storage and discarding one or more preprocessing address blocks upon a failure to match

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reading a list of one or more domain controllers from the data storage and associating the one or more domain controllers to an Internet Protocol address and to a site name obtained from a network management system

determining a domain associated with the one or more domain controllers

comparing the Internet Protocol address for each of the listed domain controllers to the list of one or more preprocessing address blocks

whereupon the step of reading preprocessing information aborts if the Internet Protocol address is within one or more preprocessing address blocks and the preprocessing site name associated with the one or more preprocessing address blocks is not the same as the site name obtained from the network management system that is associated with the one or more domain controllers

whereupon the step of reading preprocessing information continues excluding the one or more domain controllers from further processing if the Internet Protocol address is within one or more preprocessing address blocks associated with the command to ignore the one or more

preprocessing address blocks. Logan '121 discloses reading a list of one or more site names from a data storage associated with a network management system

reading from the data storage a list of one or more preprocessing site links and associated site link costs

comparing one or more site names parsed from one or more preprocessing site links to the list of one or more site names from the data storage and discarding one or more preprocessing site links upon failure to match

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reading from the data storage a list of one or more preprocessing address blocks and at least one from a set consisting of a preprocessing site name associated with the one or more preprocessing address blocks or a command to ignore the one or more preprocessing address blocks

comparing the preprocessing site name associated with the one or more preprocessing address blocks to the list of one or more site names from the data storage and discarding one or more preprocessing address blocks upon a failure to match

reading a list of one or more domain controllers from the data storage and associating the one or more domain controllers to an Internet Protocol address and to a site name obtained from a network management system

determining a domain associated with the one or more domain controllers

comparing the Internet Protocol address for each of the listed domain controllers to the list of one or more preprocessing address blocks

whereupon the step of reading preprocessing information aborts if the Internet Protocol address is within one or more preprocessing address blocks and the preprocessing site name associated with the one or more preprocessing address blocks is not the same as the site name obtained from the network management system that is associated with the one or more domain controllers

whereupon the step of reading preprocessing information continues excluding the one or more domain controllers from further processing if the Internet Protocol address is within one or more preprocessing address blocks associated with the command to ignore the one or more

preprocessing address blocks [col 16, lines 1-28.] It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaan '941 to include reading a list of one or more site names from a data storage associated with a network management system



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reading from the data storage a list of one or more preprocessing site links and associated site link costs

comparing one or more site names parsed from one or more preprocessing site links to the list of one or more site names from the data storage and discarding one or more preprocessing site links upon failure to match

reading from the data storage a list of one or more preprocessing address blocks and at least one from a set consisting of a preprocessing site name associated with the one or more preprocessing address blocks or a command to ignore the one or more preprocessing address blocks

comparing the preprocessing site name associated with the one or more preprocessing address blocks to the list of one or more site names from the data storage and discarding one or more preprocessing address blocks upon a failure to match

reading a list of one or more domain controllers from the data storage and associating the one or more domain controllers to an Internet Protocol address and to a site name obtained from a network management system

determining a domain associated with the one or more domain controllers

comparing the Internet Protocol address for each of the listed domain controllers to the list of one or more preprocessing address blocks

whereupon the step of reading preprocessing information aborts if the Internet Protocol address is within one or more preprocessing address blocks and the preprocessing site name associated with the one or more preprocessing address blocks is not the same as the site name obtained from the network management system that is associated with the one or more domain controllers

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whereupon the step of reading preprocessing information continues excluding the one or more domain controllers from further processing if the Internet Protocol address is within one or more preprocessing address blocks associated with the command to ignore the one or more preprocessing address blocks as taught by Logan '121 for the purpose of automating network directory services [col 2, lines 40-45]

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kaan '941 and Logan '121 as applied to claim 18, and further in view of US Pat No 5,850,526 issued to Chou (hereafter Chou '526).

Regarding claim 19, Kaan '941 discloses the essential elements of the claimed invention as noted above except for comparing an address of each of the one or more site references, one or more site link references, and one or more sub-network references to the one or more preprocessing address blocks

deleting from processing the one or more site references, the one or more site link references, and the one or more sub-network references having an address being a subset or superset of the one or more preprocessing address blocks and deleting from processing the partial site link associated with discontinued one or more site link references

and if the temporary site name contains no site references, deleting from processing the temporary site name and associated one or more router names, partial site links, site link references, and sub-network references.

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Chou '526 discloses comparing an address of each of the one or more site references, one or more site link references, and one or more sub-network references to the one or more preprocessing address blocks

deleting from processing the one or more site references, the one or more site link references, and the one or more sub-network references having an address being a subset or superset of the one or more preprocessing address blocks and deleting from processing the partial site link associated with discontinued one or more site link references

and if the temporary site name contains no site references, deleting from processing the temporary site name and associated one or more router names, partial site links, site link references, and sub-network references [claim 1]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaan '941 to include comparing an address of each of the one or more site references, one or more site link references, and one or more sub-network references to the one or more preprocessing address blocks

deleting from processing the one or more site references, the one or more site link references, and the one or more sub-network references having an address being a subset or superset of the one or more preprocessing address blocks and deleting from processing the partial site link associated with discontinued one or more site link references

and if the temporary site name contains no site references, deleting from processing the temporary site name and associated one or more router names, partial site links, site link references, and sub-network references as taught by Chou '526 for the purpose compressing data on a network having arbitrary LAN stations [col 3, lines 45-50]

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Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kaan '941 and Logan '121 as applied to claim 18 and further in view of US Pat No 6,442,602 issued to Choudhry (hereafter Choudhry '602).

Regarding claim 21, Kaan '941 discloses the essential elements of the claimed invention as noted above except for processing the one or more sub-network references to ensure that sub-network references are not duplicated, processing the one or more sub-network references to ensure that the network site information is minimized, and merging the one or more sub-network references associated with one or more temporary site names into the one or more site references associated with the same one or more temporary site names. Choudhry '602 discloses processing the one or more sub-network references to ensure that sub-network references are not duplicated, processing the one or more sub-network references to ensure that the network site information is minimized, and merging the one or more sub-network references associated with one or more temporary site names into the one or more site references associated with the same one or more temporary site names [col 7, lines 15-45]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaan '941 to include processing the one or more sub-network references to ensure that sub-network references are not duplicated, processing the one or more sub-network references to ensure that the network site information is minimized, and merging the one or more sub-network references associated with one or more temporary site names into the one or more site references associated with the same one or more temporary site names as taught by Choudhry '602 for the purpose of quickly and efficiently creating and managing subdomain names [col 4, lines 30-31]

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kaan '941 and Logan '121 as applied to claim 18 and further in view of US Pat No 5,872,786 issued to Shobatake (hereafter Shobatake '786).

Regarding claim 22, Kaan '941 discloses the essential elements of the claimed invention as noted above except for generating a site link between one or more temporary site names, comprising the steps of processing each partial link associated with each of the one or more temporary site names to generate a valid site link based on matching a first partial site link associated with a first temporary site name with only a second partial site link associated with a second temporary site name, reading a list of one or more site links to determine if an existing site link between the first temporary site name and the second temporary site name exists, upon existence of an existing site link, comparing a bandwidth of the existing site link to a bandwidth of the valid site link, upon the bandwidths being equal, summing the bandwidths to create a summed bandwidth and associating the summed bandwidth with the existing site link and discarding the valid site link, upon the bandwidths being unequal, maintaining the existing or valid full site link with a larger bandwidth and discarding the other of the existing or valid full site link, upon existence of the existing full site link, generating a valid site link between the first temporary site name and the second temporary site name, the valid site link including a first partial link associated with the first temporary site name and a second partial site link associated with the second temporary site name comparing the bandwidth of the first partial site link to the bandwidth of the second partial site link and upon the bandwidths being equal, generating a first link cost based on the equal bandwidth and associating the first site link cost with the valid site link, upon the bandwidths being unequal, generating a second site link cost based on the smaller

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bandwidth and associating the second site link cost with the valid site link. Shobatake '786 discloses generating a site link between one or more temporary site names, comprising the steps of processing each partial link associated with each of the one or more temporary site names to generate a valid site link based on matching a first partial site link associated with a first temporary site name with only a second partial site link associated with a second temporary site name, reading a list of one or more site links to determine if an existing site link between the first temporary site name and the second temporary site name exists, upon existence of an existing site link, comparing a bandwidth of the existing site link to a bandwidth of the valid site link, upon the bandwidths being equal, summing the bandwidths to create a summed bandwidth and associating the summed bandwidth with the existing site link and discarding the valid site link, upon the bandwidths being unequal, maintaining the existing or valid full site link with a larger bandwidth and discarding the other of the existing or valid full site link, upon existence of the existing full site link, generating a valid site link between the first temporary site name and the second temporary site name, the valid site link including a first partial link associated with the first temporary site name and a second partial site link associated with the second temporary site name comparing the bandwidth of the first partial site link to the bandwidth of the second partial site link and upon the bandwidths being equal, generating a first link cost based on the equal bandwidth and associating the first site link cost with the valid site link, upon the bandwidths being unequal, generating a second site link cost based on the smaller bandwidth and associating the second site link cost with the valid site link [col 15, line 62 through col 16, line 8]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaan '941 to include generating a site link between one or more temporary site names,

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comprising the steps of processing each partial link associated with each of the one or more temporary site names to generate a valid site link based on matching a first partial site link associated with a first temporary site name with only a second partial site link associated with a second temporary site name, reading a list of one or more site links to determine if an existing site link between the first temporary site name and the second temporary site name exists, upon existence of an existing site link, comparing a bandwidth of the existing site link to a bandwidth of the valid site link, upon the bandwidths being equal, summing the bandwidths to create a summed bandwidth and associating the summed bandwidth with the existing site link and discarding the valid site link, upon the bandwidths being unequal, maintaining the existing or valid full site link with a larger bandwidth and discarding the other of the existing or valid full site link, upon existence of the existing full site link, generating a valid site link between the first temporary site name and the second temporary site name, the valid site link including a first partial link associated with the first temporary site name and a second partial site link associated with the second temporary site name comparing the bandwidth of the first partial site link to the bandwidth of the second partial site link and upon the bandwidths being equal, generating a first link cost based on the equal bandwidth and associating the first site link cost with the valid site link, upon the bandwidths being unequal, generating a second site link cost based on the smaller bandwidth and associating the second site link cost with the valid site link as taught by Shobatake '786 for the purpose of increasing process migration without increasing a system cost [col 6, lines 5-15]

***Response to Arguments***

Applicant's arguments filed 11/3/2003, have been fully considered but they are not persuasive.

**First Applicant Argument:**

Applicant states on page 17, "Kaan in no way teaches, suggests or motivates the features that are recited in Claim 13. The citation of Kaan that allegedly anticipates Claim 13 refers to a system for managing a network, and does not even remotely teach, either directly, implicitly or inherently, the method of automatically generating network site and site link information from a router configuration file for use in a directory service that is recited in Claim 13. Therefore, it cannot and does not anticipate Claim 13, and the remainder of the cited references do not cure this deficiency of Kaan.

**First Examiner Response:**

Examiner is not persuaded. It is expedient to refer to instant specification to obtain a definition of directory service. Applicant's specification, paragraph 11 states "The network topology created by generating site and site link references is known as the Active Directory replication topology and is stored in the directory." Kaan discloses the following in paragraphs 41 and 42:

[0041] According to another configuring aspect, the host 120 has a processor 126 and a storage unit 124 with a UCCD Manager software program 122 stored thereon. This UCCD Manager software 122 has instructions which the host 120 uses to initiate a connection through a network interface device 150 to the WAN 110. The UCCD Manager program 122 also has instructions that operate with the processor 126 to further configure the router 115. That is, besides the router 115 being configured by the configuration file 116 to be recognizable by the host, etc., as was described above, the router is also configurable from the host 120, via the UCCD Manager program 122, to properly to communicate with the WAN 110. That is, it was described above that the router 115 is **automatically configured** by the bootable configuration file 116 for recognition by the mobile unit host 120, but in an alternative embodiment, the router 115 is



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configured by the UCCD Manager program 122 instead of, or in addition to the router 115 booting a configuration file 116.

[0042] The UCCD Manager program 122 provides a set of menus and windows for the user to select the type of connection to be made. The UCCD manager has a point and click user interface that is installed via a conventional CDROM using the industry standard "setup.exe" installation procedure. Once the connection type is specified and the user clicks "connect," the user can then observe the **UCCD Manager program 122 do the following**: configure the router 115 appropriately, instruct the router 115 to make the connection, test each step as the connection progresses, and finally test data transmission over the newly established link. If anything goes wrong during the connection setup, messages and dialog boxes appear to help the user diagnose the problem.

Examiner maintains that Kaan reads on the claimed "method of automatically generating network site and site link information from a router configuration file for use in a directory service" that is recited in Claim 13.

**Second Applicant Argument:**

Applicant states on page 18, "Furthermore, in view of the Declaration described above, it is respectfully requested that Kaan be removed as a prior art reference on which the rejection of Claim 13 relies.

**Second Examiner Response:**

Examiner is not persuaded for reasons given below.

***Affidavit or Declaration Under 37 CFR 1.131: Ineffective***

The affidavit filed on 11/3/2003, under 37 CFR 1.131 has been considered but is ineffective to overcome the Kaan reference for reasons given below.

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***Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient Evidence of Conception***

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date January 5, 2001, of reference document Pub. No. 2002/0065941 issued to Kaan. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

***Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient Evidence of Reduction to Practice***

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of January 5, 2001, of reference document Pub. No. 2002/0065941 issued to Kaan.

***Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Diligence Lacking***

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Kaan reference to either a constructive reduction to practice or an actual reduction to practice for the reasons given below.

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***Formal Requirements of Affidavits and Declarations:***

It is expedient to consider the formal requirements of affidavits and declarations as presented in the MPEP.

The following definition of conception is taken from MPEP § 2138.04:

Conception has been defined as “the complete performance of the mental part of the inventive act” and it is “the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice...” *Townsend v. Smith*, 36 F.2d 292, 295, 4 USPQ 269, 271 (CCPA 1930). “[C]onception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill.” *Hiatt v. Ziegler*, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). Conception has also been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without “exercise of the inventive faculty.” *Gunter v. Stream*, 573 F.2d 77, 197 USPQ 482 (CCPA 1978). See also *Coleman v. Dines*, 754 F.2d 353, 224 USPQ 857 (Fed. Cir. 1985) (It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence.); *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F. 2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986) (Conception is the “formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.”); *Hitzeman v. Rutter*, 243 F.3d 1345, 58 USPQ2d 1161 (Fed. Cir. 2001)

The following definition of reduction to practice is taken from MPEP § 2138.05:

“The nature of testing which is required to establish a reduction to practice depends on the particular facts of each case, especially the nature of the invention.” *Gellert v. Wanberg*, 495 F.2d 779, 783, 181 USPQ 648, 652 (CCPA 1974) (“an invention may be tested sufficiently ... where less than all of the conditions of actual use are duplicated by the tests”); *Wells v. Fremont*, 177 USPQ 22, 24-5 (Bd. Pat. Inter. 1972) (“even where tests are conducted under bench’ or laboratory conditions, those conditions must fully duplicate each and every condition of actual use’ or if they do not, then the evidence must establish a relationship between the subject matter, the test condition and the intended functional setting of the invention,” but it is not required that all the conditions of all actual uses be duplicated, such as rain, snow, mud, dust and submersion in water).

The following regarding facts and documentary evidence is taken from MPEP § 715.07:

A general allegation that the invention was completed prior to the date of the reference is

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not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. In *Ex parte Donovan*, 1890 C.D. 109, 52 O.G. 309 (Comm'r Pat. 1890) the court stated

If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others.

However, when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and "notes." An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In *re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

### **Declaration of Alan B. Conley and Robert C. Allen – Paragraph 3:**

We make this declaration for the purpose of establishing that a functioning version of a computer program that embodies an invention disclosed and claimed in the above-referenced

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application (hereinafter "the subject invention") was created in the United States at a date prior to January 5, 2001, which is the filing date of Kaan, and prior to October 2, 2002, which is the provisional parent application 60/237, 211 to which KAAN claims priority.

**Declaration of Alan B. Conley and Robert C. Allen – Paragraph 5:**

We, Alan B. Conley, then serving as MEMBER OF TECHNICAL STAFF, and Robert C. Allen, then serving as IT ENGINEER, were on the team that developed the "repl-gen" program, which is an enterprise management tool which, generally, parses router configuration files and determines the proper replication topology to inject into a directory service environment. As established by the attached documentary exhibits, "repl-gen" was a functioning version of a computer program that embodies the subject invention.

**Declaration of Alan B. Conley and Robert C. Allen – Paragraph 6:**

Attached, as Exhibit 1, is a true and correct redacted copy of the contents of an electronic mail from Robert Allen, which includes output from a functioning version of "repl-gen", which embodies the inventive features described and claimed in the application. The date of this document is redacted, but the true date is long prior to October 2, 2000. The test that produced the output was executed under typical working conditions and shows utility beyond probability of failure. We found that the minor errors that were present in the output were readily overcome without significant effort or experimentation. This e-mail document is maintained on a server operated by Cisco Systems, Inc., an affiliated corporation of Cisco Technology, Inc., the

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assignee of the present application; and is hereby submitted as probative of a reduction to practice of the subject invention prior to October 2, 2000.

**Declaration of Alan B. Conley and Robert C. Allen – Paragraph 7:**

Attached, as Exhibit 2, is a true and correct redacted copy of the contents of an electronic mail from Alan Conley, which describes functionality for managing Active Directory replication topology, which embodies the subject invention described and claimed in the application. This document includes descriptions of processing router configuration files and pre-processing information, and an extensive textual description of an algorithm that is embodied in the "repl-gen" program. This document was created substantially concurrently with the version of the "repl-gen" program that produced the output illustrated in Exhibit 1. The date of this document is redacted, but is long prior to October 2, 2000. This e-mail document is maintained on a server operated by Cisco Systems, Inc., an affiliated corporation of Cisco Technology, Inc., the assignee of the present application; and is hereby submitted as probative of a reduction of practice of the subject invention prior to October 2, 2000.

**Examiner's Assessment:**

Applicant has not complied with the formal requirements of 37 CFR 1.131 as outlined above. In particular, applicant has not addressed conception of the invention nor diligence in reduction to practice.

Applicant's statements regarding dates are ambiguous. Applicant states the following:

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- the date of this document [Exhibit 1] is redacted, but the true date is long prior to October 2, 2000.
- the date of this document [Exhibit 2] is redacted, but is long prior to October 2, 2000
- a reduction to practice of subject invention prior to October 2, 2000.

No dates are presented in Exhibits 1 and 2. Dates argued by applicant are the filing date of the nonprovisional application and the filing date of the provisional application of Kaan [Pub. No. 2002/0065941]. Regarding Exhibit 1, the “true date” mentioned by the inventors is unclear. Does this imply that other dates may be false. Furthermore, it is unclear to what this “true date” pertains, i.e., conception and/or reduction to practice.

Applicants give no indication when they started working on the present invention and therefore, applicants appear to be able to claim any date for conception and reduction to practice. Because applicant has not proven a conception date and diligence in reduction to practice of the present invention, the 37 CFR 1.131. affidavit has not obviated the 35 U.S.C. 102(e) rejection as being anticipated by Kaan.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Etienne LeRoux

1/7/2004



SAFET METJAHIC  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100